

S.N. 081818520 Appeal No. 2001-2250

	Date	Initials
<b>Incoming Clerk</b>		
PALM-in Case/Stamp In		
<b>Ex Parte LIE</b>		
OB/Heard Classification		
Assign Appeal No.		
Outlined		
Prepare - Mail - Enter Hearing Notice		
Prepped Hearing Case		
<b>Administrator</b>		
Assign Case		
Sign Order		
Review Case		
<b>Paralegal</b>		
Review	<u>2/6/02</u>	<u>svt</u>
Assign/ Enter Panel		
Docket Case To APJ		
Prepare Order	<u>2/4/02</u>	<u>svt</u>
Mail Order - Enter Data	<u>2/6/02</u>	<u>svt</u>
Ex parte Decision Preparation		
<b>Ex parte Legal Tech</b>		
Decision Prepared -- Proofed	<u>2-28-02</u>	<u>py</u>
Mail Decision - Entered Data	<u>3-8-02</u>	<u>py</u>
Prepped Case - To APJ		
Remailed Case		
<b>Return Remand</b>		
Assign/Redocket Case		
Enter in ACTS		

STAMP

Notes:

When case returns  
to BPAI, pls  
check w/  
Judge Nase.  
Thanks!

Notes for prepping:

Rehearing

Redocket case to APJ

Enter in ACTS

### Designation of Panel

Pursuant to 35 U.S.C. § 6(b), it is **ORDERED** that the panel of the Board of Patent Appeals and Interferences (BPAI) designated to decide this case shall consist of the following Administrative Patent Judges (APJs):

- Judge Nase
- Judge Stoner
- Judge Hackeom

Examiner Requests to Attend Hearing: ☐ Yes ☒ No

CIR E ONE: MIX BIO CHEM ELEC MECH

Rev. 01

☒ OB

☐ Heard Hrg date: \_\_\_\_\_

☐ Redesignation

☐ Expanded Panel

Bruce H. Stoner, Jr.  
Bruce H. Stoner, Jr.  
Chief Administrative Patent Judge



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER
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DATE MAILED:

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

The information disclosure statement (IDS) submitted on 06-04-01 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner. Attached is a copy of the 1449 considered by Examiner.

Sam Chuan C. Yao  
Primary Examiner  
Art Unit: 1733


ORDER

Pursuant to 37 CFR § 1.196(d), the appellants are required to file a Supplemental Appeal Brief to address the impact the Pannu decision has on the rejection before us in this appeal.

The appellants are given a non-extendable time period of **TWO MONTHS** from the mailing date of this order for response thereto. Failure to respond within this **TWO MONTH** time period will result in the dismissal of the appeal.

  
BRUCE H. STONER, JR.  
Chief Administrative Patent Judge

  
GARY V. HARKCOM  
Vice Chief Administrative Patent Judge

  
JEFFREY V. NASE  
Administrative Patent Judge

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Thus, 37 CFR § 1.196(d) authorizes the Board of Patent Appeals and Interferences (Board) to require an appellant to clarify the record by addressing any matter deemed appropriate for a reasoned decision on the appeal.

### BACKGROUND

One issue on appeal is whether claims 7 to 14, 16 to 20, 22, 23 and 25 to 27 have been properly rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

The appellants filed their appeal brief on September 25, 2000 (Paper No. 18).

The case of Pannu v. Storz Instruments, Inc., 258 F.3d 1366, 59 USPQ2d 1597 (Fed. Cir. 2001), was decided on July 25, 2001.

In Pannu the Court in discussing the recapture rule stated that "[o]n reissue, [patentee] is estopped from attempting to recapture the precise limitation [patentee] added to overcome prior art rejections." 258 F.3d at 1372, 59 USPQ2d at 1601.